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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,828	03/21/2001	Soichi Nemoto	1095.1175/JDH	1925

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/812,828		NEMOTO ET AL.	
	Examiner		Art Unit	
	Narayanswamy Subramanian		3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicants' communication filed on June 2, 2006. Amendments to claims 1, 2, 4 and 5 have been entered. Rejections made under 35 USC § 112, second paragraph in the last office action are withdrawn in view of the amendments. Claims 1-5 are currently pending. Claims 1-4 are withdrawn from consideration as discussed in the response to amendment below. Applicants are respectfully advised to cancel the withdrawn claims 1-4 and 6-12 in response to this office action. Claim 5 has been examined. The response to amendments, rejections and response to arguments are stated below.

Response to Amendment

2. Newly amended claims 1-4 are directed to inventions that is independent or distinct from the invention examined in the last office action for the following reasons:

Original claims 1-5 that were examined in the office action mailed on January 30, 2006 and amended claim 5 are drawn to a method, a computer-readable recording medium storing a program that causes a computer to implement a process and an authentication apparatus for authenticating a holder of securities, the method comprising steps of: storing customer information concerning customers in a storage unit; acquiring transaction information concerning a transaction that has been agreed in an exchange; and identifying a holder of securities after the transaction by comparing the transaction information with the customer information. Newly amended claims 1-4 are drawn to a method, a computer-readable recording medium storing a program that causes a computer to implement a process providing information about a holder of securities, the method comprising: storing customer information in a securities company server that manages customers of a securities company, the customer information including a name and

a postal address of each customer of the securities company; acquiring transaction information concerning a transaction of securities which involves a customer as a purchaser; identifying as the holder of the securities the customer who has purchased the securities by consulting the transaction information and the customer information; storing information about the name and postal address of the identified customer in the securities company server; and making the stored information about the name and postal address of the identified customer accessible to a public company that originally issued the securities purchased by the identified customer. The utility of the first invention is acquiring transaction information concerning a transaction that has been agreed in an exchange, whereas the utility of the second invention is making the stored information about the name and postal address of the identified customer accessible to a public company that originally issued the securities purchased by the identified customer. As is evident from the preamble and steps of the claimed inventions and from their different utilities, the two inventions are distinct and independent. Also the search required for amended claims 1-4 is different from that required for amended claim 5, restriction for examination purposes as indicated is proper.

3. Since applicant has received an action on the merits for the originally presented invention drawn to amended claim 5, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, amended claims 1-4 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is respectfully requested to cancel the withdrawn non-elected claims 1-4 in response to this office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation “identifying a holder of securities as a customer who has purchased the securities after the transaction”. It is not clear if the transaction involves the purchase of securities or if the securities are purchased after the transaction. Hence the scope of this claim is unclear. Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quinlan et al (US Patent 6,748,365 B1) in view of Hawkins et al (US Patent 6,247,000 B1).

Claim 5, teaches an authentication apparatus (See Quinlan Column 9 lines 13-17) comprising: means for storing customer information concerning customers in a storage unit (See Quinlan Column 6 lines 1-4); means for acquiring transaction information concerning a transaction that has been agreed in an exchange (See Quinlan Column 5 line 64 - Column 6 line 1); and means for identifying a purchaser of a product as a customer who has purchased the

product by comparing the transaction information with the customer information (See Quinlan Column 6 lines 1-7). The purchaser of a product is interpreted to include the holder of the product and an authentication apparatus is inherent in the disclosure of Quinlan.

Quinlan does not explicitly teach the step wherein the product is a security.

Hawkins teaches the step wherein the product is a security (See Hawkins Column 21 line 66 - Column 24 line 35)

Both Quinlan and Hawkins are concerned with the problem of settlement after the purchase of a product. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Quinlan to include the teachings of Hawkins. The combination of teachings suggests that buyers of securities would have benefited from dividends and/or rights issued to the purchaser by the issuing entity.

Response to Arguments

8. In response to applicant's argument that Quinlan is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant's invention is concerned with identifying the purchaser of the product (securities are financial products) and so is the invention of Quinlan (See Quinlan Column 6 lines 1-7). Hence Quinlan is pertinent prior art.

Applicant's other arguments with respect to pending claim 5 have been considered but are not persuasive.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sub Sough can be reached at (571) 272-6799. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dr. N. Subramanian *NS*
August 30, 2006

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